

REMARKS

Applicants thank the Examiner for the thorough examination given the present application.

Status of the Claims

Claims 1 and 3-4 are pending in the present application. Claim 4 is currently withdrawn from consideration. Claims 1 and 3 stand ready for further action on the merits. Claim 1 is amended to further define the present invention. Thus, no new matter has been added.

Applicants submit that the present Amendment reduces the number of issues under consideration and places the case in condition for allowance. Alternatively, entry of the present amendment is proper to place the claims in better form for appeal.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. § 112, second paragraph

Claim 1 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner asserts that the phrase “P represents a chain the exhibits syndiotacticity” is unclear.

Claim 1 is amended herein to recite “P represents a chain [[the]] that exhibits syndiotacticity.” As such, Applicants respectfully submit that the rejection is overcome and should be withdrawn.

Issues over the Cited Reference

Claims 1 and 3 are rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Schwindeman et al. ‘054 (US 6,160,054).

Applicants respectfully traverse. Reconsideration and withdrawal of this rejection are respectfully requested.

Legal Standard for Determining Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art.” *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Legal Standard for Determining Prima Facie Obviousness

MPEP 2141 sets forth the guidelines in determining obviousness. First, the Examiner has to take into account the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), which has provided the controlling framework for an obviousness analysis. The four *Graham* factors are:

- (a) determining the scope and content of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating any evidence of secondary considerations.

Graham v. John Deere, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

Second, the Examiner has to provide some rationale for determining obviousness. MPEP 2143 sets forth some rationales that were established in the recent decision of *KSR International Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

As the MPEP directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. *See* MPEP 2143.03.

Distinctions over the Cited Reference

The Examiner contends that the polymers disclosed in Schwindeman et al. '054 are obtained from, for example, isoprene. The Examiner further asserts that since the polymers are obtained via specific catalyst polymerization that is statistically similar to the disclosed process, it is reasonably believed that at least statistically the polymer disclosed must inherently contain at least some syndiotactic diads.

Schwindeman et al. '054 disclose that "FG is a protected or non-protected functional group; Q is a saturated or unsaturated hydrocarbyl group derived by incorporation of a compound selected from the group consisting of conjugated diene hydrocarbons, alkenylsubstituted aromatic hydrocarbons, and mixtures thereof" (col. 2, lines 24-28). As such, the monomers used in Schwindeman et al. '054 are limited to conjugated diene hydrocarbons (e.g., isoprene) and alkenylsubstituted aromatic hydrocarbons (i.e., styrene).

Therefore, Schwindeman et al. '054 fail to disclose or suggest a telechelic polymer having a syndiotactic chain in the polymer made from monomers specified in claim 1 of the present invention.

Accordingly, the present invention is not anticipated by Schwindeman et al. '054 since the reference does not teach or provide for each of the limitations recited in the pending claims.

Moreover, a *prima facie* case of obviousness has not been established. To establish a *prima facie* case of obviousness of a claimed invention, all of the claim limitations must be disclosed by the cited reference. As discussed above, Schwindeman et al. '054 fail to disclose all of the claim limitations of independent claim 1, and claim 3 dependent thereon. Accordingly, the reference does not render the present invention obvious.

Furthermore, the cited reference or the knowledge in the art provides no reason or rationale that would allow one of ordinary skill in the art to arrive at the present invention as claimed. Therefore, withdrawal of the outstanding rejection is respectfully requested. Any contentions of the USPTO to the contrary must be reconsidered at present.

Conclusion

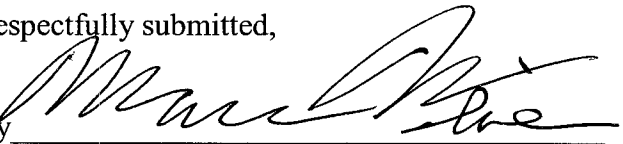
All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink, Registration No. 58,258, at the telephone number of the undersigned below to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

Dated: May 18, 2010

Respectfully submitted,

By 

Marc S. Weiner
Registration No.: 32,181
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road, Suite 100 East
P.O. Box 747
Falls Church, VA 22040-0747
703-205-8000